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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/922,487	08/03/2001	Christopher I. Halliday		7011

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12/14/2009

EXAMINER

BATES, KEVIN T

ART UNIT	PAPER NUMBER
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2456

MAIL DATE	DELIVERY MODE
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12/14/2009

PAPER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CHRISTOPHER I. HALLIDAY

Appeal 2009-001932
Application 09/922,487
Technology Center 2400

Decided: December 14, 2009

Before KENNETH W. HAIRSTON, JOHN A. JEFFERY and
CARL W. WHITEHEAD, JR., *Administrative Patent Judges*.

WHITEHEAD, JR., *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant appeals under 35 U.S.C. § 134 from the Examiner's rejection of claims 41-43, 45-53, 55-64 and 74-81. App. Br. 5. We have jurisdiction under 35 U.S.C. § 6(b) (2002). We affirm.

STATEMENT OF THE CASE

Appellant invented a method of alerting the user when a work of authorship matching the work stored by the user in the memory of a receiver is playing on another satellite audio radio channel other than the current user's channel.¹

Claim 61,² which further illustrates the invention, follows:

61. A method of selecting a satellite audio radio channel, comprising the steps of:

receiving one or more digital satellite audio radio channels using a single mobile receiver, wherein one or more of the channels includes additional information that indicates the content of one or more of the channels; comparing the information on one or more of the received digital satellite audio radio channels with a designation of a work of authorship that was selectively saved in a memory by a user when the work of authorship was playing on the receiver to determine whether the user designated work of authorship is currently playing on one or more of the digital satellite audio radio channels receivable by the receiver, wherein the step of comparing the information occurs while the receiver is providing audio to the user; and alerting the user to a satellite audio radio channel other than the channel that

¹ See generally App. Br. 10-11.

² Appellant states claim 61 is generally representative of the claims (App. Br. 17).

the user is currently listening to, wherein the channel to which the user is alerted is playing the user designated work of authorship.

*The Rejections*³

The Examiner relies upon the following prior art references as evidence of unpatentability:

Wall, Jr.	US 6,055,244	Apr. 25, 2000
Owens	US 6,067,278	May 23, 2000
Barton	US 6,233,398 B1	May 15, 2001
Robbins	US 6,317,882 B1	Nov. 13, 2001
Titlebaum	US 6,549,774 B1	Apr. 15, 2003

Claims 41-43, 45, 47, 48, 50-53, 55, 56, 58, 60⁴-64, 74-78 and 81 stand rejected under 35 U.S.C. § 103(a), as being unpatentable over Robbins, Titlebaum and Owens (Ans. 3-15).

Claims 46 and 57 stand rejected under 35 U.S.C. § 103(a), as being unpatentable over Robbins, Titlebaum, Owens and Barton (Ans. 16).

Claims 49, 59, 79 and 80 stand rejected under 35 U.S.C. § 103(a), as being unpatentable over Robbins, Titlebaum, Owens and Wall, Jr. (Ans. 16-17).

³ Examiner has withdrawn the 35 U.S.C. § 112, first paragraph rejection of claims 41-43, 45-53, 55-64 and 74-81 (Ans. 17).

⁴ Although the Examiner's statement of the rejection omits claim 60, the Examiner nevertheless addresses claim 60 in the body of the rejection *Compare* Ans. 3 *with* Ans. 7. Accordingly, we presume that the Examiner intended to include claim 60 in this rejection and treat the Examiner's error as harmless.

Rather than repeat the arguments of Appellant or the Examiner, we refer to the Brief and the Answer for their respective details. In this decision, we have considered only those arguments actually made by Appellant. Arguments which Appellant could have made but did not make in the Brief have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii) (2008).

Obviousness Rejection

Appellant argues that Robbins relies upon a receiver system which consists of multiple receivers to accomplish what the claimed invention does with only one receiver. *See* App. Br. 20-23. Further, Appellant argues that the ID codes disclosed in Robbins are automatically stored in the receiver's memory as opposed to the claimed invention which stores ID codes based upon the user's selection (App. Br. 23).

ISSUES

Has Appellant shown that the Examiner erred in finding that the claimed single mobile receiver is obvious in view of Robbins' receiver system?

Has Appellant shown that the Examiner erred in finding that the claimed ID codes were obvious in view of the ID codes disclosed in the Robbins reference?

FINDINGS OF FACTS

Robbins

1. Figure 8a of Robbins is reproduced below:

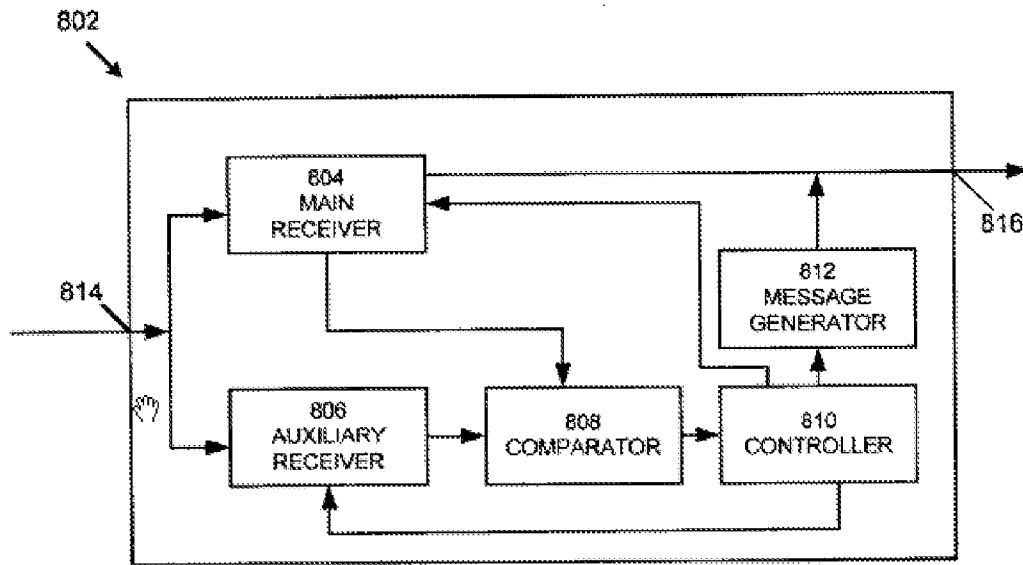


Figure 8(a) discloses an embodiment of the invention having a receiving system that includes several receivers.

2. Figure 8b of Robbins is reproduced below:

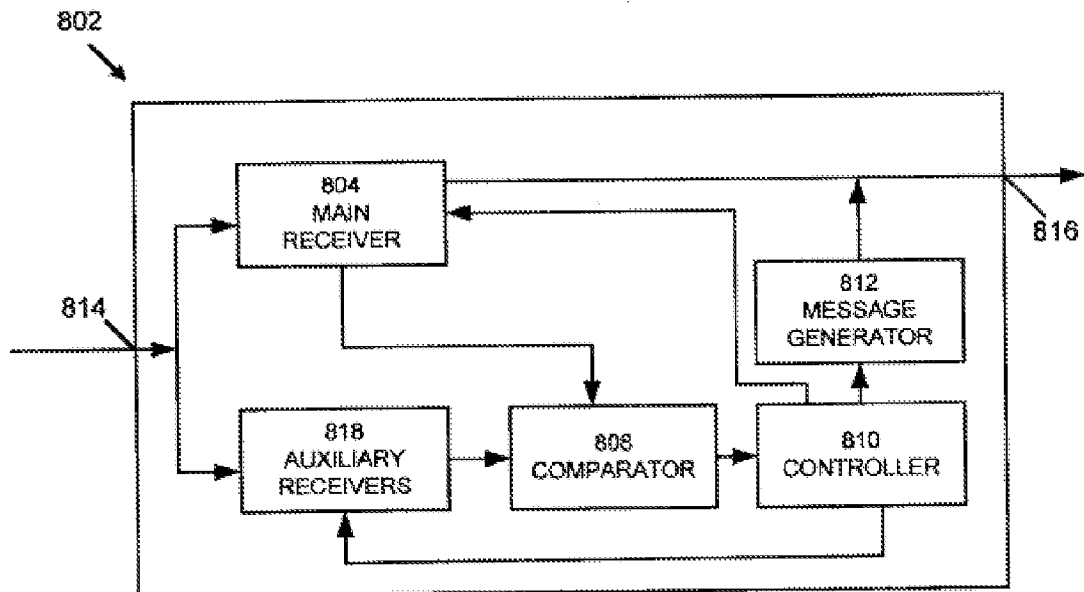


Figure 8(a) discloses an embodiment of the invention having a receiving system with several receivers including multiple auxiliary receivers.

3. FIG. 8(a) discloses a receiving system 802 that includes a main receiver 804 for receiving a spectrum of data streams that carry data signals; an auxiliary receiver 806 for scanning the spectrum of data streams; a comparator 808 for comparing data; a controller 810 for controlling the auxiliary receiver 806 and receiver unit 804, an input 814 for inputting the spectrum of data streams into the main receiver 804, and the auxiliary receiver 806; a message generator 812 for generating a reminder message for a user; and an output 816 for outputting the signal to a respective video and/or speaker (Col. 40, ll. 11-20).

4. Robbins discloses that a user activates a specific function of a receiver and the receiver detects and stores an identification (ID) code that was transmitted within the received signal (Col. 4, ll. 15-20).

PRINCIPLES OF LAW

Appellant has the burden on appeal to the Board to demonstrate error in the Examiner's position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) (“‘On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness.’” (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998))).

[T]he court erred in concluding that a patent claim cannot be proved obvious merely by showing that the combination of elements was obvious to try. When there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill in the art has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely the product not of innovation but of ordinary skill and common sense.

KSR Int'l Co. v. Teleflex Inc., 550 U.S. 398, 402-03 (2007).

It is an obvious expedient to the skilled artisan to integrate into a single unit individual devices that were known in the art to be separate but operating together. *In re Larson*, 340 F.2d 965, 968 (CCPA 1965).

“A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant.” *In re Kahn*, 441 F.3d 977, 990 (Fed. Cir. 2006) (citations and internal quotation marks omitted). *See also In re Fulton*, 391 F.3d 1195, 1201 (Fed. Cir. 2004) (noting that merely disclosing more than one alternative does not teach away from any of these alternatives if the disclosure does not criticize, discredit, or otherwise discourage the alternatives).

“Where claimed subject matter has been rejected as obvious in view of a combination of prior references, a proper analysis under § 103 requires, inter alia, considerations of two factors: (1) whether the prior art would have suggested to those of ordinary skill in the art that they should make the

claimed composition or device, or carry out the claimed process; and (2) whether the prior art would also have revealed that in so making or carrying out, those of ordinary skill would have had a reasonable expectation of success.” *In re Vaeck*, 947 F.2d 488, 493 (Fed. Cir. 1991) (citations omitted). “Obviousness does not require absolute predictability of success For obviousness under § 103, all that is required is a reasonable expectation of success.” *In re O’Farrell*, 853 F.2d 894, 903-04 (Fed. Cir. 1988).

ANALYSIS

Robbins employment of multiple receivers

Appellant argues that none of the references employs the same receiver to save a designation of work of authorship while scanning for selections in real time (App. Br. 20). Further, Appellant argues that none of the references employs the same receiver to scan for selections in real time while providing the user audio and notification alerts. *Id.* See also Reply Br. 4. The Examiner takes the position that Robbins’ receiver system is the entire box 802 composed of multiple components but still functions as a singular receiver in the same manner as the claimed invention. See Ans. 18. The Examiner acknowledges Robbins uses a receiver system, but argues that the *only actual difference* between the claimed invention and Robbins is nomenclature (Ans. 18).

We agree with the Examiner’s characterization because while it is clear that Robbins employs multiple receivers to form one homogenous receiver system, the internal components of Appellant’s receiver have not been disclosed. Appellant does not provide any support for his position that

the claimed receiver differs from the receiver system employed by Robbins. In fact, Appellant argues that the *claimed invention accomplishes with one satellite audio receiver that which previously would have required two or more receivers* (App. Br. 22). Robbins accomplishes the same feat by combining multiple receivers into a singular receiver system. *See* FF 1-3. Appellant provides examples of how the components of Robbins interact with each other to accomplish what his invention does with only one receiver (App. Br. 23-25). However, just because Robbins employs multiple receivers to achieve what the claimed invention does with one receiver is not enough to patentably distinguish the claimed invention over Robbins since integrating separate components into one singular component is an obvious expedient to the skilled artisan. *See Larson*, 340 F.2d at 968. Thus, we do not find the Appellant's argument persuasive.

Appellant attempts to specify a distinction between Robbins' auxiliary receivers storing ID codes that are not user selected and Robbins main receivers storing ID codes that are user selected (App Br. 23). Upon integrating the multiple receivers into a single receiver, which is an obvious expedient, this becomes a moot argument because the single receiver would store the user selected ID codes. Further, the ID codes stored in the auxiliary receivers are actually a consequence of user preferences and therefore they are user selected. *See* FF 4. Thus we do not find the Appellant's arguments persuasive.

Robbins teaching away from employment of one receiver

Appellant argues that Robbins teaches away from the use of a single receiver because *one of skill in the art would not have been motivated to*

integrate the auxiliary and main receivers together with any expectation of success (App. Br. 26). Appellant's assertion that Robbins teaches away from the use of multiple receivers is based upon Robbins' disclosure of reducing the number of auxiliary receivers while maintaining that auxiliary receivers are still required (App. Br. 27). We disagree with Appellant's assertion. Robbins states, "[t]he reduction in cost may be reflected in the decrease in the needed auxiliary receivers" (Col. 35, ll. 53-54). Robbins does not teach away from consolidating the receivers; in fact, Robbins suggests just the opposite by disclosing that reducing the number of receivers is a cost saving option. *See Kahn*, 441 F.3d at 990; *Fulton*, 391 F.3d at 1201 (noting that merely disclosing more than one alternative does not teach away from any of these alternatives if the disclosure does not criticize, discredit, or otherwise discourage the alternatives).

No expectation of success

Appellant further argues that forcibly modifying Robbins in the manner suggested by the Examiner would render Robbins *unsatisfactory* for its intended purpose and function (Ans. 29). It is the Appellant's theory that in the absence of one or more auxiliary receivers, no scanning occurs and therefore Robbins becomes non-functional. *Id.* As we pointed out previously, however, Robbins indicates that the number of receivers can be reduced without derailing the original purpose and intent of the invention. Therefore one skilled in the art would have had a reasonable expectation of success when integrating the multiple receivers. Further, Appellant has provided no evidence, other than a mere assertion, that one skilled in the art would not reasonably expect success when integrating the multiple

receivers. Mere lawyer's arguments and conclusory statements that are unsupported by factual evidence are entitled to little probative value. *In re Geisler*, 116 F.3d 1465, 1470 (Fed. Cir. 1997); *see also In re De Blauwe*, 736 F.2d 699, 705 (Fed. Cir. 1984). Thus, we do not find Appellant's arguments persuasive.

Examiner rejects limitations not present in the claims

Appellant argues that the Examiner rejects claim limitations that are not currently present in the claims (App. Br. 30-31). This is an error of no consequence and has no bearing upon the issues as long as Examiner addresses the limitations that are actually in the claims.

Claims 46, 49, 57, 59, 79 and 80

Appellant asserts that continued rejections in view of Brown were in error because Brown was not germane to the issues of the instant application other than for the fact that the reference establishes that one of skill in the art would have not proceeded in the same technical direction as the Appellant (App. Br. 31). The Examiner acknowledges the error of referring to Brown in the rejections and states that the prosecution history clearly shows Brown was replaced by Titlebaum (Ans. 17). The Examiner maintains that while the rejection statements reflected reliance upon the Brown reference, the substance of the rejection nevertheless relied upon the Robbins and Titlebaum combination. *See* Ans. 17. Appellant acknowledges this oversight, but nonetheless fails to timely address the rejections based upon Titlebaum instead of Brown. *See* App Br. 31. Since the Examiner's clerical errors in this regard are undisputed (and are deemed to be harmless in any

event), Appellant has not persuasively rebutted the Examiner's prima facie case of obviousness for dependent claims 46, 49, 57, 79 and 80 based upon the combination of Robbins and Titlebaum. *See* App. Br. 31.

Claims 43, 52, 74 and 76

Appellant asserts that the Examiner failed to address claim limitations generally directed to *alerting a user* (App. Br. 31). However, in rejecting claims 43 and 52, Examiner indicated Robbins discloses *alerting a user* of desired content if the user designation of a work of authorship matches a station designation of a work authorship (Ans. 5). Therefore, Appellant has not persuasively rebutted the Examiner's prima facie case of obviousness established in the rejection of claims 43, 52, 74 and 76. *See* App. Br. 31.

Claims 43 and 52

Appellant's argument centralizes upon Robbins' reliance upon auxiliary receivers that repeatedly scans a channel (App. Br. 31). It is Appellant's position that Robbins only use the term *repeatedly* in context with scanning that occurs in the auxiliary receivers and therefore Robbins fails to disclose using only one receiver for scanning. *See Id.* We do not find this argument persuasive for the same reasons we have stated previously. It would have been an obvious expedient of one of ordinary skill in the art to integrate the multiple receivers into a single receiver and therefore the scanning would occur within one receiver. Therefore, Appellant has not persuasively rebutted the Examiner's prima facie case of obviousness established in the rejection of claims 43 and 52.

Claims 41, 42, 45, 47, 48, 51, 53, 55, 56, 58-60, 62-64, 75, 77, 78 and 81

Appellant did not address the merits of independent claims 41 and 75 individually and since Appellant has not persuasively rebutted the Examiner's prima facie case of obviousness over Robbins, Titlebaum and Owens, we will sustain the Examiner's rejection of independent claims 41 and 75. Therefore, claim 42 falls with claim 41 from which it depends; while claims 45, 47, 48, 50 and 51 fall with claim 43 from which they depend; claims 53, 55, 58-60 and 56 (which ultimately depend upon claim 52) fall with claim 52 from which they depend; claims 62-64 fall with claim 61 from which they depend; and claims 77, 78 and claim 81 (which ultimately depend upon claim 76) fall with claim 76 from which they depend. *See In re Nielson*, 816 F.2d 1567, 1569, 1572 (Fed. Cir. 1987) (dependent claims, not argued separately, fall with the independent claim, even though the dependent claims were rejected based on additional (or different) references.).

CONCLUSIONS

Appellant has not shown that the Examiner erred in finding that the claimed single mobile receiver is obvious in view of Robbins' receiver system.

Appellant has not shown that the Examiner erred in finding that the claimed ID codes were obvious in view of the ID codes disclosed in the Robbins reference.

ORDER

Appeal 2009-001932
Application 09/922,487

We will sustain the Examiner's decision rejecting claims 41-43, 45-53, 55-64 and 74-81.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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